

a dummy region having a plurality of dummy trench isolation patterns located in [between said first and] said second region [regions], wherein the dummy trench isolation patterns comprise a trench pattern which constitutes a positioning mark and extends in a second direction different from the first direction so as to connect said dummy trench isolation patterns.

REMARKS

Claims 1, 2, 4 and 11 are pending in this application. Claim 1 has been amended. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment should be apparent throughout the written description of the specification, notably the depicted embodiments, including Figs. 1 through 15, and the related discussion thereof in the written description of the specification. Applicants submit that the present Amendment does not generate any new matter issue.

A clean copy of amended claim 1 appears in the Appendix hereto.

Claims 1, 2, 4 and 11 were rejected under the second paragraph of 35 U.S.C. §112.

In the statement of the rejection, the Examiner asserted that the phrase "a second region adjacent to the first region" renders the claimed invention indefinite as to what is included or excluded. This rejection is traversed as factually and legally erroneous.

Indefiniteness under the second paragraph of 35 U.S.C. §112 is a **question of law**, not form. *Personalized Media Communications LLC v. U.S. International Trade Commission*, 161 F.3d 696, 48 USPQ2d 1880 (Fed. Cir. 1998); *Tillotson, Ltd v. Wlaboro*

Corp., 831 F.2d 1033, 4 USPQ2d 1450 (Fed. Cir. 1987); *Orthokinetics Inc. v. Safety Travel Chairs Inc.*, 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986). Accordingly, in rejecting a claim under the second paragraph of 35 U.S.C. §112, the Examiner must provide a basis and fact and/or cogent technical reasoning to support the ultimate legal conclusion that one having ordinary skill in the art, with the supporting specification in hand, would not be able to reasonably ascertain the scope of protection defined by a claim. *In re Okuzawa*, 537 F.2d 545, 190 USPQ 464 (CCPA 1976). Significantly, consistent judicial precedents holds that reasonable precision in light of the particular subject matter involved is all that is required by the second paragraph of 35 U.S.C. §112. *Zoltek Corp. v. United States*, *supra*; *Miles Laboratories, Inc. v. Shandon, Inc.*, 997 F.2d 870, 27 USPQ2d 1123 (Fed. Cir. 1993); *North American Vaccine, Inc., v. American Cyanamid Co.*, 7 F.3d 1571, 28 USPQ2d 1333 (Fed. Cir. 1993); *U.S. v. Teletronics Inc.*, *supra*; *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 23 USPQ (Fed. Cir. 1986). Applicant stresses that claims must be interpreted as one having ordinary skill in the art would have interpreted the claims in light of and consistent with the supporting specification. *Zoltek Corp. v. United States*, *supra*; *Miles Laboratories, Inc. v. Shandon, Inc.* *supra*.

In applying the above legal tenets to the exigencies of the case, Applicants submit that the Examiner did not discharge the initial burden of establishing a *prima facie* basis to deny patentability to the claimed invention under the second paragraph of 35 U.S.C. §112. Indeed, rather than discharging the judicially imposed burden of **explaining why** the claims are indefinite consistent with procedural **due process of law**, the Examiner

merely offered a conclusion. Thus, as an initial matter, the rejection should be withdrawn for failure to state a prima facie basis case.

Further, Applicant would stress that one having ordinary skill in the art would have no difficulty understanding the scope of the claimed invention, including what is meant by the first region and adjacent second region, particularly when reasonably interpreted in light of and consistent with the written description of the specification, noting the embodiments depicted in Figs. 1 through 15 and the related discussion thereof of the written description of the specification. Applicants would note that claim 2 defines the first and second regions with greater specificity.

At any rate, in order to expedite prosecution, claim 1 ~~has~~ ✓ been amended by ✓ clarifying that the dummy region is formed in the second region and that the dummy trench isolation patterns comprising the dummy region comprise a trench pattern which connects the dummy trench isolation patterns. Applicant submits that one having ordinary skill in the art would have no difficulty understanding the scope of the claimed invention, particularly when reasonably interpreted in light of and consistent with the written description of the specification, as judicially mandated. *Miles Laboratories, Inc. v. Shandon, Inc., supra.*

Applicant, therefore, submits that the imposed rejection of claims 1, 2, 4 and 11 under the second paragraph of 35 U.S.C. §112 is not legally viable and, hence, solicits withdrawal thereof.

Claims 1, 2, 4 and 11 were rejected under 35 U.S.C. §103 for obviousness predicated upon Shimizu.

In the statement of the rejection, the Examiner adhered to previous reasoning referring to various figures and excerpts of Shimizu et al. This rejection is traversed

As argued throughout prosecution, the Examiner has failed to comply with judicial mandates by identifying a source in the applied prior art for each claim limitation, i.e., column and line. *Smiths Industries Medical System v. Vital Signs Inc.*, 183 F.3d 1347, 51 USPQ2d 1415 (Fed. Cir. 1999). Throughout prosecution, the Examiner has declined to identify wherein Shimizu et al. disclose or even suggest a dummy trench isolation pattern comprising a pattern which constitutes a positioning mark and extends in a second direction different from the first direction as recited in independent claim 1. The Examiner persists in noting a mask for an area--**which is not a positioning mark.**

The bottom line is that the Examiner has not discharged his burden by pointing out wherein Shimizu et al. disclose or suggest a structure as claimed, even without the present Amendment, comprising, inter alia, a dummy region having a plurality of dummy trench isolation patterns which constitutes a positioning mark and extends in a second direction different from the first direction.

At any rate, in order to expedite prosecution, claim 1 has been amended to clarify that the dummy region has a plurality of dummy trench isolation patterns located in the second region. Claim 1 further recites that the dummy trench isolation patterns comprise a trench pattern, and that this trench pattern connects the dummy trench isolation patterns. Clearly, Shimizu et al. neither disclose nor suggest such a structure.

Should the Examiner persist in applying Shimizu et al., the Examiner is respectfully requested to comply with the mandates of the Court of Appeals for the Federal Circuit and identify precisely wherein the features of the claimed invention are perceived to reside in Shimizu et al. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). **Failure of the Examiner to comply with such mandates of the Court of Appeals for the Federal Circuit would constitute arbitrary agency action and deny Applicant the right to procedural due process of law. *In re Mullin*, 481 F.2d 1333, 179 USPQ 97 (CCPA 1973).**

Applicant would again stress that Shimizu et al. neither disclose nor suggest a structure corresponding to that defined in independent claim 1 comprising, inter alia, a dummy region having a plurality of dummy trench isolation patterns located in the second region, wherein the dummy trench isolation patterns comprise a trench pattern which constitutes a positioning mark and extends in a second direction different from the first direction so as to connect said dummy trench isolation patterns. Further, there is no apparent factual basis of record upon which to predicate the conclusion that one having ordinary skill in the art would have been realistically impelled to deviate from the teachings of Shimizu et al. to arrive at the claimed invention absent, of course, **improperly** reliance upon Applicant's disclosure. *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 227 USPQ 337 (Fed. Cir. 1985).

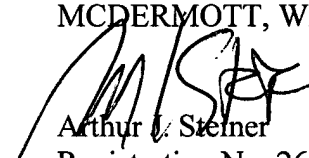
Applicant, therefore, submits that the imposed rejection of claims 1, 2, 4 and 11 under 35 U.S.C. §103 for obviousness predicated upon Shimizu et al. is not factually or legally viable and, hence, solicits withdrawal thereof.

It should, therefore, be apparent that the imposed rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY



Arthur L. Steiner
Registration No. 26,106

600 13th Street, N.W.
Washington, DC 20005-3096
(202) 756-8000 AJS:ntb
Facsimile: (202) 756-8087
Date: December 30, 2002